

REMARKS

The Office Action dated September 14, 2005, has been carefully considered. Responsive thereto, Applicant has amended the claims as indicated above, and requests that the Examiner consider the following remarks.

Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,904,840 (DiBella) in view of U.S. Patent No. 5,603,825 (Costinel). Claims 1 and 2 were rejected under 35 U.S.C. 103(a) as being unpatentable over DiBella ('840) in view of Costinel ('825). Claims 3 – 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over DiBella ('840) in view of Costinel ('825), and further in view of U.S. Patent No. 6,752,920 (Harris). Claim 6 was indicated as being allowable.

Claim 1 has been amended. Claims, 3, 5, and 6 have been cancelled. New claim 7 has been added. Claims 1, 2, 4, and 7 remain pending. New claim 7 includes all the limitations of cancelled claim 6 and its intervening claims, and is thus considered in condition for allowance in view of the Examiner's comments with regard to the allowability of claim 6.

The claims have been amended to a scope that is considered to be allowable in view of the issues raised by the Examiner in the Office Action. No new matter has been added. Reconsideration is respectfully requested.

Applicant is filing herewith a copy of an Assignment executed by named co-inventor Michael M. Anthony in favor of first named inventor Alberto DiBella.

Double Patenting Rejection

Claim 1 was rejected under the judicially created doctrine of obviousness over claim 1 of U.S. Patent No. 5,904,840 in view of U.S. Patent No. 5,603,825 (Costinel). It is the Examiner's position that claim 1 (including auxiliary filtration) of the present application is obvious in view of claim 1 of U.S. Patent No. 5,904,840 in view of the U.S. Patent No. 5,603,825 (Constinel).

Applicant respectfully suggests that the Double Patenting Rejection is improper. More particularly, it appears that the Examiner has confused double patenting with the ability to have dominant claims included in a first patent and to properly have narrower claims directed to a similar invention included in a second patent. In this situation the narrow claim (claim 1 of the present application) cannot be infringed without infringing the dominant claim of the '840 Patent.

In this connection the Federal Circuit held in *In re Kaplan*, 789 F.2d 1574 (Fed. Cir. 1986) as follows:

By dominating we refer, in accordance with established patent law terminology to the phenomenon, which grows out of the fact that patents have claims, whereunder one patent has a broad or "generic" claim which "reads on" an invention defined by a narrower or more specific claim in another patent, the former "dominating" the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim . . . In possibly simpler terms, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure. This commonplace situation is not, per se, double patenting as the [Examiner] seemed to think. *Id.* at 681.

Applicant submits that the Double Patenting Rejection is improper in view of the dominance of the '804 Patent (DiBella), and should be withdrawn.

Rejections Under 35 U.S.C. §103(a)

Claims 1 – 5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over DiBella, Costinel, and Harris taken in various combinations.

U.S. Patent No. 5,603,825, issued to Costinel, discloses a multi-stage oil-water separator for removing oily contaminants from bilge water in ships. The Examiner cites Costinel for disclosing auxiliary filtration downstream of a centrifugal apparatus. Costinel, however, merely reveals a single separator having internal stages, and does not disclose a voraxial separator combined with a self-cleaning auxiliary stage as disclosed by Applicant.

The Examiner attempts to remedy the deficiency of Costinel by reliance on Harris et al. (6,752,920). Harris discloses a self-cleaning filter having an inlet, an outlet, a flush inlet and a flush outlet. The Examiner relies on Harris for disclosing a self-cleaning means as disclosed by Applicant. Upon closer inspection, however, Applicant notes that Harris does not disclose rotating spray tubes. In contrast, the spray tubes (8) disclosed by Harris are fixed. See, tubes 8 in FIGS. 19 and 20. The system disclosed by Harris relies on the back flush fluid to “drag the filter disks 7 in a right handed rotational direction.” See, Col. 26, lines 15 – 17. Since filters can become clogged with debris, the configuration disclosed by Harris is deemed less reliable than the system disclosed by Applicant, particularly in situations wherein heavy filter loading prevents the filter

from rotating. Applicant discloses and claims an auxiliary filter system wherein self-cleaning is accomplished by an elongate spray tube disposed within said cylindrical filter and means for rotating the spray tube within said cylindrical filter. Harris neither teaches or suggests such a system.

The claims have been amended to a scope commensurate with the Examiner's comments and prior art of record.

Further, Applicant believes that the rejections under 35 U.S.C. 103(a) are not properly supported. More particularly, Applicant is unable to find any teachings or suggestions that it would be desirable to combine the references as suggested by the Examiner.

It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art contain something to suggest the desirability of doing so. Ex parte Walker, 135 U.S.P.Q. 195 (1961). Furthermore, the Examiner must identify where the prior art provides a motivating suggestion for the combination. In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The Federal Circuit, in In re Jones, confirmed that "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so . . ." (citing In re Fine, 837 F.2d 1071, 1074 (Fed Cir. 1988)).

The cited references fail to teach or suggest the desirability of the combined teachings relied on by the Examiner. Accordingly, the proposed combinations are improper and fail to support rejection under 35 U.S.C. § 103.

See, C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 USPTQ.2d 1225 (Fed. Cir. 1998) (There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination).

It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987). During prosecution, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987) (A holding that claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35). As the Federal Circuit has often stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

Accordingly, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the law requires the examiner to show a motivation to combine the references that create the case of obviousness. In Re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, is not evidence.

The Federal Circuit has identified three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the

teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. Id. In the present case the Examiner relies upon none of the three possible sources for motivation. Instead, after each citation of a particular feature in the cited art, the Examiner summarily concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of X by combining Y.” The Examiner has not, however, explained what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. When the Examiner does not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the present invention to make the combination, it is presumed that the Examiner selected the references with the assistance of hindsight. Id. at page 1358.

While a suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997), rarely will the skill in the art operate to supply missing knowledge or prior art to reach an obviousness judgment. In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). If such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Id.

In Ex Parte Clapp, 227 USPQ 972, claims were rejected under 35 U.S.C. §103 when the Examiner combined a number of references. The Board in Clapp

set out the requirement that the Examiner state a line of reasoning as to why the artisan, viewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. The Board in Clapp noted that the Examiner had done little more than “cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. 227 USPQ 972, 973. The Board held that “to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” 227 USPQ 972, 973. The Board could not find anything in the references to expressly or impliedly teach or suggest the modifications urged by the Examiner, nor could the Board find a line of reasoning advanced by the Examiner as to why the artisan would have concluded that the modifications urged by the Examiner were obvious. The Board held that, on the record before it, “the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.”

Applicants also rely on the decision of the Court of Appeals for the Federal Circuit in Carella v. Starlight Archery, 231 USPQ 644. One of the issues in Carella was the obviousness of the invention over the prior art. The CAFC noted that the Court below had acknowledged that use of vertical height for range

finding, use of multiple elements on a sight and use of circular apertures were each known in the art, but concluded that the prior art lacked any teaching or suggestion to combine the separate features in a manner permitting use of circular apertures for simultaneous range finding. Obvious cannot be established by combining the teachings of the prior art to produced the claimed invention absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Both Carelly and Clapp stand for the proposition that the art, not the Examiner, must teach the suggested combination. Further, if the references do not expressly or impliedly suggest the claimed combination then the burden falls on the Examiner to advance a line of reasoning which supports the position advanced by the Examiner.

In Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1498, 1 USPQ.2d 1337, 1343 (Fed. Cir. 1986), the court stated: "the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would suggest the desirability, and thus the obviousness, of making the combination." The record does not reveal any such suggestion or teaching that would lead to the Applicants' claimed invention.

In view of the amendments and arguments presented herein it is believed that that the claims are patentably distinguishable over the prior art. Accordingly, Applicants respectfully requests a favorable action on this case.

Should the Examiner have any questions, comments, or concerns, the undersigned would appreciate a telephone conference in order to expedite this case.


This Amendment is considered as being timely filed by certificate of mailing dated January 17, 2006 within 4-months of the Office Action dated September 14, 2005 in view of the federal holiday (MLK Day) on Monday January 15, 2006, along with a petition for 1-month extension of time and appropriate fee.

Respectfully submitted,

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By: 
Mark D. Bowen, Esquire
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INVENTION/PATENT ASSIGNMENT

WHEREAS, Michael M. Anthony ("Assignor") has participated in the invention and the development of certain new, non-obvious and useful improvements in a VORAXIAL FILTRATION SYSTEM WITH SELF-CLEANING AUXILIARY FILTRATION APPARATUS ("Invention") disclosed in a United States Patent Application to be filed with the United States Patent and Trademark Office;

WHEREAS, ALBERTO DIBELLA, a Florida resident, with an address of 3500 Bayview Drive, Ft. Lauderdale, Florida ("Assignee"), is desirous of acquiring the entire right, title and interest in and to said Invention and Application, and in and to any and all utility and design patents that may be granted therefor in the United States and in any and all foreign countries;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to Assignor in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignor hereby sells, assigns and transfers, to said Assignee the full and exclusive right to the said Invention and Application including any and all rights to past, present, and future damages relating to infringements thereof, if any, in the United States and its territorial possessions and in all foreign countries and the entire right, title, and interest in and to any and all utility and design patents which may be granted therefor in the United States and its territorial possessions and in any and all foreign countries and in and to all divisions, reissues, continuations and extensions thereof.

Assignor hereby authorizes and requests the United States Patent and Trademark Office in the United States and any and all foreign countries to issue any and all patents, when granted, to said Assignee as the assignee of the entire right, title, and interest in and to the same, for the sole use and enjoyment of said Assignee, its successors and assigns.

Further, Assignors agree they will communicate to said Assignee or its representatives, any facts known to them respecting said Invention, and testify in any legal proceedings, sign all lawful papers, execute all divisions, continuations, substitutions, renewal and reissue Application, execute all necessary assignment papers to cause any and all of said utility patent to be issued to said Assignee, make all rightful oaths, and generally do everything necessary or desirable to aid said Assignee, its successors and assigns, to obtain and enforce proper protection for said Invention in the United States and in and all foreign countries.

ASSIGNOR:

By: _____

Michael M. Anthony

Date: 11-13-03

**PLEASE SIGN
& DATE**

STATE OF FLORIDA)
): SS:
COUNTY OF BROWARD)

Sworn to before me by _____ this _____ day of _____, 2003.

Notary Public, State of Florida at Large

Print type or stamp commissioned
name of Notary Public

My Commission Expires:

_____ Personally known OR
_____ Produced identification, type of identification produced: _____